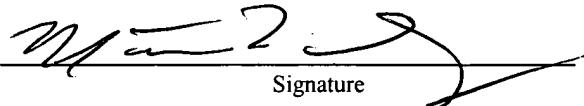




|  |  |                                |
|--|--|--------------------------------|
| <b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>   |  | Docket Number:<br>06975-029001 |
| <p>I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop AF, Commissioner for Patents, Box 1450, Alexandria, VA 22313-1450.</p> <p>Date of Deposit _____</p> <p>Signature _____</p> <p>Typed or Printed Name of Person Signing Certificate _____</p>   | Application Number<br>09/582,261       | Filed<br>October 10, 2000      |
|  | First Named Inventor<br>William KENNEY |                                |
|  | Art Unit<br>2667                       | Examiner<br>Anh Ly             |
|  | _____                                  |                                |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a Notice of Appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s).</p> <p>Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest.<br/>See 37 CFR 3.71. Statement under 37 CFR 3.73(b)<br/>is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record <u>47,074</u><br/>(Reg. No.)</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.<br/>Registration number if acting under 37 CFR 1.34<br/>_____</p> <p><br/>Signature</p> <p><u>Matthew T. Shanley</u><br/>Typed or printed name</p> <p><u>(202) 783-5070</u><br/>Telephone number</p> <p><u>February 17, 2006</u><br/>Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.</p> <p><input checked="" type="checkbox"/> Total of 8 pages are submitted.</p> |  |                                |



Attorney's Docket No.: 06975-029001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : William Kenney

Art Unit : 2667

Serial No. : 09/582,261

Examiner : Anh Vu H. Ly

Filed : October 10, 2000

Title : LOCALIZATION OF CLIENTS AND SERVERS

**Mail Stop AF**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Pursuant to United States Patent and Trademark Office OG Notices: 12 July 2005 - New Pre-Appeal Brief Conference Pilot Program, a request for a review of identified matters on appeal is hereby submitted with the Notice of Appeal. Review of these identified matters by a panel of examiners is requested because the rejections of record are improper and are without basis, in view of a clear legal or factual deficiency in the rejections. All rights to address additional matters on appeal in any subsequent appeal brief are hereby reserved.

Claims 1-24 are pending, with claims 1, 11, 16, and 22 being independent. Claims 1-24 have been rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Britton et al. (U.S. 6,442,577). Applicant respectfully traverses this rejection.

Applicant specifically requests the panel to review the following issues:

1. The rejection under 35 U.S.C. § 102(e) is improper as Britton et al. does not describe or suggest each and every limitation of independent claims 1, 11, 16 and 22.
2. While the Office appears to acknowledge that Britton does not explicitly describe or suggest every limitation of the independent claims, the Office is improperly relying upon Official Notice to suggest features that are not inherent in Britton.

Each of these issues is discussed in greater detail below. Applicant reserves the right to expand these issues and/or present new issues when filing their appeal brief.

**Discussion of Issues:**

1. Britton et al. does not describe or suggest each and every limitation of independent claims 1, 11, 16 and 22.

Claims 1 and 22 recite, in part, a method for data transfer between a host system, a database, and a terminal server that includes querying a database to obtain service data associated with the geographic location of the terminal server based on the terminal server identifier. The geographic location specific service data is sent automatically from the host system to the terminal server.

Britton does not describe or suggest any service data associated with the geographic location of a terminal server. Britton does not describe or suggest querying a database that is queried to obtain service data associated with the geographic location of the terminal server based on a terminal server identifier. Accordingly, this rejection is improper.

Instead, Britton describes an Internet Content Provider (ICP) that maintains a database of static Internet Protocol (IP) addresses that are assigned to a particular organization. See Britton, col. 6, lines 15-26; Fig. 3. Upon receiving a request for data from a particular IP address, the ICP captures the IP address and compares it against IP addresses stored in a participant database. See Britton, col. 7, lines 36-44. The ICP then finds the name of the organization in the participant database and looks up associated information based on the organization name. See Britton, col. 6, lines 50-53; Figs. 3-4. Based on the organization name, Britton then suggests delivery of a webpage containing customized advertising content. Specifically, the ICP looks up the IP address in an advertising database, locates the owner's name of the advertisement to be displayed, and locates the corresponding files in the advertisement file database. See Britton col. 7, lines 14-19; Figs. 5-6. Britton's method for dynamically forming customized web pages is therefore based entirely on the IP address and name of participant organizations.

However, Britton does not determine the geographic location of the terminal server from which the request is received. Moreover, Britton does not maintain or track any information related to a geographic location. The tables illustrated in Britton do not contain geographic

location information. See Britton, Figs. 3-6. Thus, Britton does not describe or suggest a database that is queried to obtain service data associated with the geographic location of the terminal server. Britton's method does not deliver geographic location specific service data from the host system; in fact, the Office incorrectly points to Britton, e.g., col. 5, lines 1-7, to suggest that an IP address corresponds to an assigned geographic location. Specifically, the Office equates the IP address of an organization with a terminal server identifier that would implicitly or inherently include a geographic information regarding the user. See page 7, lines 3-19. This position is factually incorrect, is unsupported by any evidence in the prior art of record to substantiate the opinions advanced in the Office Actions, and has been timely traversed by Applicant.

Applicant submits that an IP address does not contain any geographic information. The four sets of numbers in an IP address indicate the relevant domain, network, subnetwork, and host computer. The IP address does not identify a geographic location corresponding to an organization or client computer. Although Britton describes the use of a formal server identifier (IP Address), Britton does not relate that identifier to a geographic location. In fact, Britton does not even maintain any information related to a geographic location, making it clear that Britton fails to describe any method or database that may be used to map an IP address to a geographical location. For at least the reason discussed above, claims 1-24 are patentable over Britton.

With respect to claim 11, a host system includes, in part, a database including a record associating a terminal server identifier with service data specific to a geographic location. Britton does not describe any database including record associating a terminal server identifier with service data specific to a geographic location. The Office has not provided any evidence of a database having the above-described features anywhere in Britton.

With respect to claim 16, a computer program includes, in part, instructions for causing a computer to query a database to obtain service data associated with the geographic location of the terminal server based on the terminal server identifier. The geographic location specific service data is sent automatically from the host system to the terminal server. As described in connection with claims 1 and 22, the Office has not provided any evidence of querying a

database to obtain service data associated with the geographic location of the terminal server based on the terminal server identifier. Accordingly, claims 1-24 are patentable over Britton.

2. While the Office appears to acknowledge that Britton does not explicitly describe or suggest every limitation of the independent claims, the Office is improperly relying upon Official Notice to suggest shortcomings that would allegedly be inherent in Britton. No evidence has been provided which supports the Office's stated position.

It is inappropriate for the Office to take Official Notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. The rejection based upon Britton specifically relies upon the erroneous position that "An IP address identifies who you are and where you are from. Therefore, it contains geographic information regarding the user." See Office Action mailed October 17, 2005, page 7, lines 3-19. This position was similarly advanced in the Office Action dated March 28, 2005, page 3, lines 1-7. Applicant traversed this position in the response dated July 25, 2005. The Office responded by stating: "For further information, please see RFC 1918 IP address." However, the Office has not provided any published document, website, or location of such a document. Further, Applicant submits that RFC 1918, e.g., <http://rfc.dotsrc.org/rfc/rfc1918.html>, does not support the Office's stated position. Accordingly, this rejection is improper and must be withdrawn.

Applicant submits that the Office has admitted that Britton does not explicitly describe or suggest that an IP address includes geographic information. Specifically, page 7 of the Office Action dated October 17, 2005 suggests that an IP address inherently includes geographic information. However, the only evidence to support the opinion stated at page 7 of the Final Office Action is recited at lines 18-19, where the Examiner instructs the Applicant "For further information, please see RFC 1918 IP address." A document entitled "RFC 1918 IP address" was not provided with the Final Office Action and no information sufficient to identify its location was provided by the Examiner. During a telephone call conducted with Applicant's

Applicant : William Kenney  
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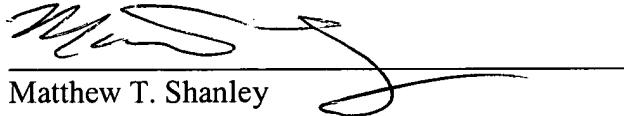
representative in February 16, 2005, Applicant was instructed on by Examiner Ly to "look-up" RFC 1918 IP address on the internet. Applicant submits that since the Office has not provided any evidence to support these opinions, the rejection is an improper use of Official Notice. See MPEP § 2144.03 In order to investigate the Examiner's position, Applicant searched the internet to attempt to identify "RFC 1918 IP address." Applicant did not identify any document relating to "RFC 1918 IP address" that stated an IP address includes any geographic information related to a user. See, e.g., <http://rfc.dotsrc.org/rfc/rfc1918.html>.

If this rejection is maintained in any form, the panel is requested to provide any evidence that allegedly supports the position that an IP address includes geographic information regarding the user. Applicant submits that claims 1-24 are patentable over Britton.

Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: \_\_\_\_\_

  
Matthew T. Shanley  
Reg. No. 47,074

**PTO Customer No.: 26171**  
Fish & Richardson P.C.  
1425 K Street, N.W.  
11th Floor  
Washington, DC 20005-3500  
Telephone: (202) 783-5070  
Facsimile: (202) 783-2331